

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

LG. PHILIPS LCD., CO., LTD.,)
)
Plaintiff,)
)
v.) CIVIL ACTION NO. CV-04 11076 (RCL)
)
MICHELE B. BOVIO &)
ROBERT C. FRAME,)
)
Defendants.)
)

**FRCP 12(b)(1) MOTION OF DEFENDANT ROBERT C. FRAME TO
DISMISS FOR LACK OF SUBJECT MATTER JURISDICTION**

Pursuant to FRCP 12(b)(1) of the Federal Rules of Civil Procedure, defendant Robert C. Frame (“Frame”) respectfully requests that this Court dismiss plaintiff LG. Philips LCD., Co. Ltd.’s (“LPL”) claims against him in this matter. Pursuant to both Article III and the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2201, this Court lacks subject matter jurisdiction unless LPL can prove an “actual controversy” between the named parties. Here, there is no actual controversy between LPL and Frame because (1) Frame has not created in LPL a “reasonable apprehension” that he will bring an action under 35 U.S.C. § 256 to correct inventorship on the patents at issue in this case (“Side-Mount Patents”), and (2) Frame does not have a right to bring such an action. Through his counsel, Frame has advised LPL in writing that he will *not* sue to correct inventorship on these patents. As LPL has argued in another litigation involving these same Side-Mount Patents, that statement in itself defeats subject matter jurisdiction. Further, Frame does not have the *right* to bring an action to correct inventorship under section 256 given that he has assigned all of his rights in the Side-Mount Patents to his previous employer, and, therefore, Frame lacks a present ownership, financial or other interest necessary to confer standing to sue LPL on the Side-Mount Patents.

Even setting aside the “actual controversy” requirement, this Court should exercise its broad discretion in dismissing this case in favor of LPL’s other currently-pending lawsuits concerning the Side-Mount Patents. On August 29, 2002, LPL filed a patent infringement action against three defendants - Chunghwa Picture Tubes, Ltd. (“CPT”), Tatung Co. of America and Tatung Company – in the Central District of California. The only issue raised by LPL’s First Amended Complaint here – the inventorship of the Side-Mount Patents – is squarely before Judge Consuelo B. Marshall in the California case, having been raised in CPT’s original Answer and Counterclaims and is also the primary basis for CPT’s motion for summary judgment set for hearing on August 9, 2004. Frame suspects that LPL filed this case hoping to litigate the inventorship issue from a clean record with additional time for discovery and to intimidate and harass Frame and defendant Michele B. Bovio and discourage them from cooperating as fact witnesses in the California case. In order to avoid inconsistent decisions and wasting the parties’ and the court’s resources, this case should be dismissed in favor of the California case filed by LPL nearly two years ago.

The legal and factual support for this Motion is set forth in the attached Memorandum of Law.

REQUEST FOR ORAL ARGUMENT

Pursuant to D. Mass. LR 7.1(d), defendant Robert C. Frame believes that oral argument may assist the Court and hereby requests oral argument on this motion.

The Defendant,
ROBERT C. FRAME
By his Attorneys,

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CERTIFICATE OF COUNSEL

I, Andria Coletta, attorney for defendant, Robert C. Frame, hereby certify that the parties conferred prior to filing the above motion in accordance with Local Rule 7.1. I further certify that, on July 22, 2004, I mailed a copy of the following FRCP 12(b)(1) Motion of Defendant Robert C. Frame To Dismiss For Lack of Subject Matter Jurisdiction by regular mail, postage prepaid, to Andrew M. Higgins, Casner & Edwards, LLP, 303 Congress St., Boston, MA 02210 and Anthony C. Roth, Morgan, Lewis & Bockius LLP, 1111 Pennsylvania Ave., N.W., Washington, D.C. 20004.

Andria Coletta BBO No. 636930

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